

## **REMARKS**

### **I. STATUS OF APPLICATION**

The limitations of claim 3 have been incorporated into independent claim 1 and claim 3 has been canceled. Accordingly, claims 1, 2, 4-25 and 36-40 are pending in the present Application. No claims are amended, added, or canceled in this paper.

Claims 1-25 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-6 of co-pending U.S. Patent Application 11/072,382 ("the '382 Application").

Claims 1-25 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting, as being unpatentable over claims 1-25 of co-pending U.S. Patent Application 10/524,367 ("the '367 Application") in view of U.S. Patent 5,300,171 to Braun *et al.* ("Braun").

Claims 1-25 and 36-40 stand rejected under 35 USC § 103(a), as being unpatentable over U.S. Patent 6,372,323 to Kobe *et al.* ("Kobe") in view of Braun and U.S. Patent 6,960,272 to Tokas *et al.* ("Tokas").

### **II. PROVISIONAL DOUBLE PATENTING REJECTIONS**

#### **A. Provisional rejection of claims 1-25 over claims 1-6 of the co-pending '382 Application**

Claims 1-25 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-6 of the co-pending '382 Application.

Applicant notes the provisional rejection, which will be taken up in due course upon the allowance of either the present Application or the '382 Application.

**B. Provisional rejection of claims 1-25 over claims 1-25 of the co-pending '367 Application in view of Braun**

Claims 1-25 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting, as being unpatentable over claims 1-25 of the co-pending '367 Application in view of Braun.

Applicant notes the provisional rejection, which will be taken up in due course upon the allowance of either the present Application or the '367 Application. Applicant, however, does not acquiesce in this rejection, but rather chooses to take up this rejection if and when a non-provisional rejection is made by the Office.

**III. 35 USC § 103 REJECTIONS**

Claims 1-25 and 36-40 stand rejected under 35 USC § 103(a), as being unpatentable over Kobe in view of Braun and Tokas. Note that in the specific rejection,<sup>1</sup> the Office only lists claims 1-25 as being rejected; however, in the discussion of the rejection, claims 36-40 are addressed. Therefore, it is believed that claims 1-25 *and* 36-40 are rejected. *Clarification is respectfully requested.* Applicant respectfully asserts that the combination of Kobe, Braun, and Tokas fails to render the present invention obvious, as discussed below.

In the consideration and determination of obviousness under 35 U.S.C. 103, the four factual inquires<sup>2</sup> used as a background for determining obviousness are (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in

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<sup>1</sup> Detailed Action, ¶ 5.

<sup>2</sup> See *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

the pertinent art; and (4) evaluating evidence of secondary considerations. In determining the differences between the prior art and the claims, the question under 35 USC § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.<sup>3</sup> A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention.<sup>4</sup> The U.S. Supreme Court reinforces this principle in its decision in *KSR Int'l. Co. v. Teleflex, Inc.*,<sup>5</sup> stating that “when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.”<sup>6</sup>

The prior art must disclose each and every element of the claimed invention.<sup>7</sup> Even if the prior art discloses every element of the claimed invention, it is legally insufficient to conclude that a claim is obvious “merely by demonstrating that each of its elements was, independently, known in the prior art.”<sup>8</sup> When the claimed invention is not a “predictable use of prior art elements according to their established functions,” the claimed invention cannot be found to be obvious.<sup>9</sup> For example, when the elements of the claimed invention work together “in an unexpected and fruitful manner,” the claimed invention was not obvious to one skilled in the art at the time of the invention.<sup>10</sup> Moreover, “rejections on obviousness grounds cannot be sustained by mere conclusory

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<sup>3</sup> *MPEP 2141.02*, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

<sup>4</sup> *MPEP 2141.02*, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

<sup>5</sup> *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. \_\_\_\_ (2007).

<sup>6</sup> *KSR*, slip op. at 12, citing *United States v. Adams*, 383 U.S. 39, 40 (1966).

<sup>7</sup> *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

<sup>8</sup> *KSR*, slip op. at 14.

<sup>9</sup> *KSR*, slip op. at 13.

statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”<sup>11</sup> The Office must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”<sup>12</sup> The Office must also make “explicit” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art.”<sup>13</sup> Anything less than such an explicit analysis is insufficient to support a *prima facie* case of obviousness. Such an analysis must not “read into the prior art the teachings of the invention in issue” and must “guard against slipping into the use of hindsight.”<sup>14</sup>

**A. Claims 1, 2, and 4-25 are allowable over the cited references**

Independent claim 1 requires “a dimensionally stable, thin plastic film” and “a thin layer of silicone elastomer *having a durometer of less than 30 on the Shore A scale* disposed on a first surface of the plastic film” (emphasis added). It should be noted that the Office relies upon only Kobe and Braun in the rejection of claim 1. The Office alleges that Kobe’s additional backing layer 22 is the claimed plastic film and that Kobe’s backing layer 21 with stems 26 make up the claimed layer of silicone elastomer.<sup>15</sup> The Office acknowledges that “Kobe fails to disclose that the silicone

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<sup>10</sup> KSR, slip op. at 12.

<sup>11</sup> KSR, slip op. at 14, citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006).

<sup>12</sup> KSR, slip op. at 15.

<sup>13</sup> KSR, slip op. at 14.

<sup>14</sup> KSR, slip op. at 17.

<sup>15</sup> Detailed Action, p. 3, ll. 19-21.

elastomer has a low durometer, more specifically less than 40 on the Shore A scale”<sup>16</sup> but relies upon Braun to teach this limitation.<sup>17</sup> Applicant respectfully submits, however, that Braun fails to disclose a silicone elastomer having a durometer of *less than 30* on the Shore A scale, as required by claim 1. The characteristic of having a durometer of less than 30 on the Shore A scale provides critical frictional properties to the claimed film<sup>18</sup> and, thus, the durometer is not merely a result effective variable, as alleged by the Office.

Applicant respectfully asserts that the present invention, as set forth in independent claim 1, would not have been obvious to one of ordinary skill in the art at the time of the invention. One of ordinary skill in the art would have appreciated that it would not be desirable to use a silicone elastomer having a durometer of less than 30 on the Shore A scale, as required by claim 1, in the upstanding stems of Kobe because such silicone elastomers exhibit shear strengths that are lower than desirable for Kobe’s article.<sup>19</sup> Moreover, one of ordinary skill in the art at the time of the invention would have appreciated that silicone elastomers having durometers of less than 30 on the Shore A scale are difficult to bond to other materials and, thus, such a person would have avoided using such silicone elastomers in implementations wherein the silicone elastomer was applied to another material.<sup>20</sup>

Accordingly, as recited in claim 1, “a dimensionally stable, thin plastic film” works together with “a thin layer of silicone elastomer *having a durometer of less than 30 on*

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<sup>16</sup> Detailed Action, p. 4, ll. 6-7.

<sup>17</sup> Detailed Action, p. 4, ll. 20-21.

<sup>18</sup> Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, ¶ 6.

<sup>19</sup> *Id.*, ¶ 7.

<sup>20</sup> *Id.*, ¶ 7.

*the Shore A scale* disposed on a first surface of the plastic film” in an unexpected and fruitful manner. Thus, the present invention, as set forth, in claim 1, cannot be obvious in light of Kobe, Braun, and Tokas. Claims 2 and 4-25 depend from claim 1; therefore, the remarks provided *supra* concerning claim 1 apply equally to claims 2 and 4-25.

#### **B. Claims 6-10 are separately allowable over the cited references**

Claim 6 further requires the silicone elastomer to have “a polished surface finish.” The Office alleges that “the limitation ‘polished’ is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results.”<sup>21</sup> Moreover, the Office states that “Applicant has not provided evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from the prior art.”<sup>22</sup>

Concerning the Office’s allegation that the limitation “polished” is a method limitation, Applicant reiterates his traversal of this allegation, as the limitation “polished” is not a method limitation but is, instead, structural in nature.

In *In re Garnero*,<sup>23</sup> the CCPA held certain limitations to be structural rather than process limitations. Claim 1 in *Garnero* recited:

*A composite, porous, thermal insulation panel characterized by dimensional stability and structural strength consisting essentially of expanded perlite particles which are interbonded one to another by interfusion between the surfaces of the perlite particles while in a pyroplastic state to form a porous perlite panel.*<sup>24</sup>

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<sup>21</sup> Detailed Action, p. 5, ll. 10-12.

<sup>22</sup> Detailed Action, p. 10, ll. 20-21.

<sup>23</sup> *In re Garnero*, 412 F.2d 276, 162 USPQ 221, 223 (CCPA 1969).

<sup>24</sup> *Garnero*, 162 USPQ at 222.

On appeal to the CCPA, the solicitor for the Patent Office argued that the limitation “interbonded one to another” was a process limitation that was not a patentable distinction over the prior art. The CCPA disagreed and held the limitation to be a structural limitation, stating that:

*it seems to us that the recitation of the particles as “interbonded one to another by interfusion between the surfaces of the perlite particles” is as capable of being construed as a structural limitation as “intermixed,” “ground in place,” “press fitted,” “etched,” and “welded,” all of which at one time or another have been separately held capable of construction as structural, rather than process, limitations....*<sup>25</sup>

This reasoning reads directly on the present case with only slight modification for the technologies involved. A “polished surface finish” is a structural limitation of the silicone elastomer, not merely the result of a process for making the silicone elastomer. Accordingly, “polished surface finish” must be given patentable weight.

The Office alleges “Kobe meets the limitation that the silicone elastomer has a polished surface finish, since figures 1 and 8 clearly show non-raised or flat portion on the article.”<sup>26</sup> Claims, however, are construed in light of the specification, of which they are a part.<sup>27</sup> The present Specification teaches “[t]he phrase ‘surface finish’ will be used herein to describe the surface of materials on a very fine, or microscopic, scale....”<sup>28</sup> While the drawings of Kobe show enlarged views, and in those views the surfaces of Kobe’s article

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<sup>25</sup> *Garnero*, 162 USPQ at 223. See also *Hazani v. United States Int’l Trade Comm’n*, 12 F.3d 1473, 44 USPQ2d 1358, 1363 (Fed. Cir. 1997) (citing *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (CCPA 1971)):

*Hazani argues that the “chemically engraved” claims are product-by-process claims. We agree with the respondents, however, that those claims are best characterized as pure product claims, since the “chemically engraved” limitation, read in context, describes the product more by its structure than by the process used to obtain it.*

<sup>26</sup> Detailed Action, p. 5, ll. 16-18.

may appear smooth, Kobe is completely silent with regard to any surfaces being having polished surface finishes, *i.e.*, polished on a microscopic scale, as required by claim 6. Not only must the prior art suggest the claimed invention, the prior art must disclose each and every element of the claimed invention.<sup>29</sup> The cited references, however, fail to meet this standard.

If the Office persists in its allegation that the limitation “polished” is a method limitation, Applicant respectfully requests the Office to provide evidence that the limitation should be considered a method limitation. If the Examiner is relying upon personal knowledge that the limitation should be considered a method limitation, Applicant respectfully requests an affidavit executed by the Examiner supporting the contention.

Concerning the Office’s statement that “Applicant has not provided evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from the prior art,”<sup>30</sup> Applicant respectfully asserts that the Office must proffer a *prima facie* case of obviousness, which the Office has failed to do, before Applicant is required to rebut the case with evidence:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d

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<sup>27</sup> *Phillips v. AWH Corporation*, 415 F.3d 1303, 1315-16 (Fed. Cir. 2005).

<sup>28</sup> WO 2005/026434, p. 5, ll. 2-3.

<sup>29</sup> *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

<sup>30</sup> Detailed Action, p. 10, ll. 20-21.



1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at \_\_\_\_ , 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

The Office has the burden to specify wherein the prior art each of the limitations can be found in order to make out a *prima facie* case of obviousness. Specifically, the Office must either point to wherein Kobe a polished surface finish is disclosed or provide evidence of why the Office believes Kobe's surfaces are polished. Absent such a recitation by Kobe or such evidence, a *prima facie* case of obviousness cannot be made.

Applicant respectfully requests the Office to provide evidence that Kobe's surfaces are polished. If the Examiner is relying upon personal knowledge that the surfaces of Kobe are polished, Applicant respectfully requests an affidavit executed by the Examiner supporting the contention.

For at least these additional reasons, claims 6-10 are allowable over Kobe, Braun, and Tokas.

### **C. Claim 11 is separately allowable over the cited references**

Claim 11 requires the texture to be "an array of upraised dimples," examples of which are shown in Figure 3. The Office alleges that "Kobe discloses that the textured is in an array of upraised dimples (*figures 1 and 8*)."<sup>31</sup> A dimple, however, for example, is "an indented, hollowed, or depressed area in the surface of something."<sup>32</sup> The Office contends that "the spaces between the projections are depression areas, e.g. dimples."<sup>33</sup> Applicant, however, respectfully maintains that Kobe fails to disclose an array of upraised dimples, as

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<sup>31</sup> *Detailed Action*, p. 6, ll. 9-10.

<sup>32</sup> See <http://encarta.msn.com/encnet/refpages/search.aspx?q=dimple>.

<sup>33</sup> *Detailed Action*, p. 11, ll. 8-9.

required by claim 11. Applicant reserves the right to take up this issue on appeal, if desired.

**D. Claim 12 is separately allowable over the cited references**

Claim 12 requires the silicone elastomer to have “a matte surface finish.” The Office alleges that Kobe’s silicone elastomer “is deemed to [have] a matte finish since it contains projections.”<sup>34</sup> As discussed above concerning the rejection of claims 6-10, the present Specification teaches “[t]he phrase ‘surface finish’ will be used herein to describe the surface of materials on a very fine, or microscopic, scale....”<sup>35</sup> Thus, Kobe is silent with regard to its article having matte finish in the same way that Kobe fails to teach or disclose its article having a polished finish.

The Office, however, contends that “Applicant has not provided evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from the prior art.”<sup>36</sup> Rather, Applicant provided a specific reference to Applicant’s Specification to provide guidance in construing the claims in general and this limitation in particular. Such a reference is not merely “attorney argument.” “[T]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.”<sup>37</sup>

The Office has arbitrarily deemed a surface having projections to be the claimed matte surface finish resulting in an allegation that is *prima facie* deficient. Applicant respectfully requests the Office to provide reasoned, technical evidence that a surface

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<sup>34</sup> *Detailed Action*, p. 6, ll. 11-12.

<sup>35</sup> *WO 2005/026434*, p. 5, ll. 2-3.

<sup>36</sup> *Detailed Action*, p. 11, ll. 10-12.

having projections should be construed as a matte finish. If the Examiner is relying upon personal knowledge that a surface having projections should be construed as a matte finish, Applicant respectfully requests an affidavit executed by the Examiner supporting the contention.

Accordingly, the present invention, as set forth in claim 12, is separately allowable over Kobe, Braun, and Tokas.

**E. Claim 13 is separately allowable over the cited references**

Claim 13 requires the plastic film to be “a heat stabilized plastic film.” The Office, however, construes the term “heat stabilized” as a method limitation.<sup>38</sup> The Office is reminded of the discussion *supra* concerning *In re Garnero*<sup>39</sup> with regard to claims 6-10. Therefore, Applicant respectfully asserts that the limitation “heat stabilized” provides a structural limitation to the plastic film.

The term “heat stabilized,” as it pertains to a plastic film, would be understood by those skilled in the art having the benefit of the disclosure in the above-referenced application to mean a film that is substantially dimensionally stable when subjected to heat.<sup>40</sup> Applicant respectfully asserts that the cited references, whether taken singly or in combination, neither disclose or suggest a heat stabilized plastic film.

If the Office wishes to persist in the rejection of claim 13, Applicant respectfully requests reasoned evidence that one or more of the cited references discloses a heat stabilized plastic film, as set forth in claim 13. Absent such reasoned evidence, the rejection of claim 13 is *prima facie* deficient and should be withdrawn.

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<sup>37</sup> *Phillips v. AWH Corporation*, 415 F.3d 1303, 1315-16 (Fed. Cir. 2005).

<sup>38</sup> Detailed Action, p. 6, l. 13.

<sup>39</sup> *In re Garnero*, 412 F.2d 276, 162 USPQ 221, 223 (CCPA 1969).

For at least these additional reasons, claim 13 is separately allowable over Kobe, Braun, and Tokas.

**F. Claim 16 is separately allowable over the cited references**

Claim 16 requires “graphical indicia associated with the plastic film.” The Office relies upon Kobe to disclose “the plastic film or silicone elastomer can be tinted with pigments or dyes (col. 5, lines 62-67).”<sup>41</sup> The cited portion of Kobe discloses:

*The thermoplastic materials may also contain additives, including but not limited fillers, fibers, antistatic agents, lubricants, wetting agents, foaming agents, surfactants, pigments, dyes, coupling agents, plasticizers, suspending agents, hydrophilic/hydrophobic additives, and the like.*

Kobe is describing, in general, the types of additives that its thermoplastic materials may contain. One of ordinary skill in the art would appreciate that these additives are of the type that are added to a batch of material, rather than to create a graphical indicia. While a graphical indicia may comprise pigment or a dye, merely stating that pigment or a dye may be included in its thermoplastic material does not meet the requirement that the prior art teach or suggest all of the claimed limitations. Claim 16 is, therefore, allowable over the cited references. Applicant reserves the right to take up this issue on appeal, if desired.

**G. The Office has again failed in its burden to describe how the cited references are applied to claim 25**

As in the previous Office Action, while claim 25 is listed in the Detailed Action as being rejected under 35 USC § 103(a) over Kobe, Braun, and Tokas, the Office has failed in its burden to describe how the cited references are applied to claim 25. The

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<sup>40</sup> Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, ¶ 11.

<sup>41</sup> *Detailed Action*, p. 6, ll. 20-21 (emphasis in original).

burden includes showing an objective teaching in the cited art that would lead one of ordinary skill in the art to combine the teachings of references.<sup>42</sup> If not “readily apparent,” the examiner must explain why the combination of references is proper.<sup>43</sup> No such explanation is provided. Applicant respectfully asserts that the cited references, whether taken singly or in combination, fail to disclose or suggest “a label stock having graphical indicia adhered to the plastic film, such that the graphical indicia is visible,” as required by claim 25. Accordingly, claim 25 is allowable over the cited references.

#### **H. Claims 36-40 are allowable over the cited references**

Independent claims 36 and 40 each recite “a heat-stabilized, plastic film.” While the Office contends that the limitation “heat-stabilized” is a method limitation,<sup>44</sup> it can be seen from the discussion provided *supra* concerning claim 13 that the term “heat stabilized,” as it pertains to a plastic film, would be understood by those skilled in the art having the benefit of the disclosure in the above-referenced application to mean a film that is substantially dimensionally stable when subjected to heat.<sup>45</sup> Applicant respectfully asserts that the cited references, whether taken singly or in combination, neither disclose or suggest a heat stabilized plastic film.

If the Office wishes to persist in the rejection of claims 36 and 40, Applicant respectfully requests reasoned evidence that one or more of the cited references discloses a heat-stabilized plastic film, as set forth in claims 36 and 40. Absent such reasoned evidence, the rejection of claims 36 and 40 is *prima facie* deficient and should be withdrawn.

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<sup>42</sup> *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988).

<sup>43</sup> *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1790 (Bd. Pat. App. & Int. 1987).

<sup>44</sup> Detailed Action, p. 8, l. 16.

For at least these additional reasons, claims 36 and 40 are allowable over Kobe, Braun, and Tokas. As claims 37-39 depend from claim 36, each of these claims are also allowable over Kobe, Braun, and Tokas.

Therefore, it is respectfully requested that the rejection of claims 1-25 under 35 USC § 103(a), as being unpatentable over Kobe in view of Braun and Tokas, be reconsidered and withdrawn.

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<sup>45</sup> Declaration of Fred A. Antonini Under 37 C.F.R. § 1.132, ¶ 8.

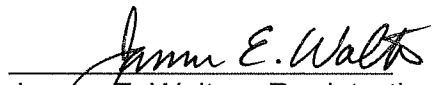
## CONCLUSION

Applicant's arguments and amendments are made without prejudice or disclaimer. Distinctions from the various references cited by the Office have been discussed by Applicant. Other distinctions, however may exist. Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Office, Applicant does not acquiesce to the Office's additional statements. Applicant's response is sufficient to overcome the Office's rejections.

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and issuance of a Notice of Allowance are earnestly solicited. The Examiner is invited to contact the undersigned with any questions, comments, or suggestions relating to the referenced patent application.

Respectfully submitted,

3/12/08  
Date

  
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